

17. (Amended) A method for capturing information from a substrate using an apparatus having a viewing area for assisting a user in positioning the apparatus over a particular area of the substrate, comprising:

positioning the apparatus over a particular area of the substrate using the viewing area;
and
capturing coded embedded data related to the orientation of the substrate.

REMARKS

This is in reply to the Examiner's Official Action dated December 5, 2001. Claims 1-32 are currently pending in the present application. The above amendment with the following remarks is submitted to be fully responsive to the Official Action. Reconsideration of this application in light of these remarks, and allowance of this application are respectfully requested.

In the Office Action Summary, the Examiner indicates an objection to the drawings filed on February 4, 2000, but does not provide adequate clarification to enable Applicants to correct/address the objection. Please provide additional information so that the objection(s) may be resolved.

In paragraph 1 of the Official Action, the Examiner objects to claim 5 due to a minor informality. By this amendment, Applicants have corrected claim 5 in accordance with the Examiner's request. Applicants therefore request withdrawal of the objection.

Claims 1-3, 9-12, 16-19, 25-28 and 32 are rejected under 35 U.S.C. § 103(a) as unpatentable over Nukui in view of Hecht. This rejection is respectfully traversed, since a *prima facie* case of obviousness has not been made by the Examiner.

To establish a *prima facie* case of obviousness under 35 U.S.C. § 103, each of three requirements must be met. First, the reference or references, taken alone or combined, must teach or suggest each and every element recited in the claims. (See M.P.E.P. § 2143.03 (8th ed. 2001).) Second, a reasonable expectation of success must exist. Third, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. Moreover, each of these requirements must "be found in the prior art, and not based on applicant's disclosure." (M.P.E.P. § 2143 (8th ed. 2001).)

According to the Examiner, Nukui allegedly teaches:

a data symbol reading device for reading a data symbol, having an indication section which notifies the device user of a positioning condition of the device relative to a symbol reading area of the data symbol on a surface. The device also features an operation switch, two light sources, and a charge coupled device.

(December 5, 2001 Official Action at page 3.) (Nukui references removed.)

The Examiner admits that Nukui fails to specifically teach coded embedded data, and she cites Hecht for disclosing these features. The Examiner further alleges that:

[o]ne of ordinary skill in the art would have readily recognized that a glyph code may store a large amount of data that is hidden and is undetectable with the unaided eye, thereby causing dishonest and unauthorized decoding of the code more difficult. Therefore, it would have been obvious, at the time the invention was made, to modify the teachings of Nukui with the coded embedded data as taught by Hecht.

(Id. at page 3.) For the reasons described herein, Applicants respectfully disagree with the Examiner's conclusions.

Independent claims 1 and 17 of the Applicants' invention are directed to an apparatus and method, respectively, for, among other things, capturing coded embedded data related to the orientation of a substrate.

According to the Examiner, Hecht teaches "a glyph code pattern written on a suitable recording medium, whereas data encodings are transversely interlaced with spatial addressing information". (December 5, 2001 Official Action at page 3.) The Examiner does not assert, nor does either reference, teach or suggest coded embedded data indicative of the orientation of the substrate. Moreover, the references, whether considered separately or together do not disclose or suggest an apparatus or method for capturing coded data related to the orientation of the substrate. For at least these reasons, the combination of Nukui in view of Hecht fails to render obvious the present claimed invention. As described below, Nukui in view of Hecht fails to establish a *prima facie* case of obviousness for additional reasons as well.

In Hecht, the embedded data provides "the relative addresses of the glyphs in standard Cartesian coordinates (i.e., "x" and "y" parameters expressed in units of glyphs)." (Hecht at col. 2, lines 2-4.) For all practical purposes, the spatial address (i.e., "x" and "y" coordinates) of a glyph is meaningless without information on the orientation of the substrate. Hecht does not

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disclose, teach, or suggest the capability to retrieve the orientation of a substrate. In fact, none of the cited references disclose the capability to retrieve the orientation of a substrate as claimed.

Accordingly, the prior art references fail to teach or suggest all the claim limitations. Therefore, a *prima facie* case of obviousness has not been established. More specifically, none of the cited references disclose the capability to retrieve the orientation of a substrate. Therefore, reconsideration and withdrawal of the rejection of claims 1 and 17 under 35 U.S.C. §103(a) is in order and respectfully requested. Withdrawal of the rejection of claims 2-3, 9-12, 16, 18, 19, 25-28 and 32 is likewise in order as they depend from allowable base claims.

The Examiner also rejects claims 4-8, 13-15, 20-24 and 29-31 under 35 U.S.C. § 103(a) as unpatentable over Nukui-Hecht as applied to claim 1, and further in view of U.S. Patent No. 5,513,264 to Wang. According to the Examiner, Nukui-Hecht admittedly "lack[s] the teaching of a viewing area comprising a display for displaying an image based on the coded embedded data" and she cites Wang for allegedly teaching this feature. For the same reasons articulated above, Applicants respectfully submit that the withdrawal of the rejection of claims 4-8, 13-15, 20-24 and 29-31 under 35 U.S.C. § 103(a) is in order as they depend from allowable base claims.

In view of the foregoing, it is submitted that the present application is in condition for allowance and a notice to that effect is respectfully requested. However, if the Examiner deems that any issue remains after considering this response, she is invited to call the undersigned to expedite the prosecution and work out any such issue by telephone.

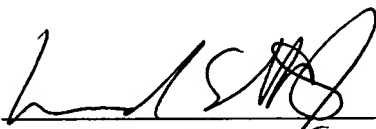
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Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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